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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,394	01/16/2004	Daniel R. Foster	13213-061001	6690
26191	7590	09/26/2006	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/759,394	FOSTER, DANIEL R.	
	Examiner	Art Unit	
	Gary C. Hoge	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 18-24 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 17 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Two drawing sheets</u> .               |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8, 9, 12, 18-24, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Struhl (5,275,438).

Struhl discloses a card comprising a front panel 4 and a rear panel 6 connected at a fold line, the front panel having a front surface, a plurality of peripheral edges, and an interior surface, and a collapsible bag structure 18 attached to the front surface such that the collapsible bag structure is positioned forward of the front panel, the collapsible bag structure having outer edges spaced apart from the peripheral edges of the front panel so that a substantial portion of the front surface of the front panel is viewable (col. 3, lines 36-37), the collapsible bag structure having at least one fold line (col. 3, lines 52-56) such that at least a portion of the structure (i.e., the flap 42) is adjustable to a collapsed condition, wherein the collapsible bag structure is operable to releasably retain an object (the recitation that the object is a gift card is a statement of intended use), and wherein the peripheral edges of the front panel include a top edge 12a and a left edge 14b, the collapsible bag structure has an opening 44 that faces toward the top edge of the front panel, and the fold line at which the front panel and rear panel are connected is disposed proximal to the left edge of the front panel. See Fig. 1.

Regarding claims 1 and 9, a “bag” is defined as “a container of flexible material, such as paper, plastic, or leather, that is used for storing items.”

Regarding claims 2, 3 and 20, a larger bag of the type disclosed by Struhl could be used as a shopping bag.

Regarding claims 4 and 22, Struhl discloses a retention element 52.

Regarding claim 12, an “envelope” is defined as “something that envelops; a wrapping.” The retaining means disclosed by Struhl meets that definition.

Regarding claim 18, the claim is a subcombination claim drawn to a card and a container. Limitations drawn to the object to be placed in the container are merely statements of intended use and do not patentably distinguish the claim over the prior art.

Regarding claim 21, the bag structure disclosed by Struhl is capable of retaining a prepaid gift card. The recitation that the bag “resembles a shopping bag from a retail store” is merely an ornamental consideration, and it has been held that matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re Seid*, 73 USPQ 431.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 12, 18-24, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guderyon (5,288,144) in view of Struhl (5,275,438).

Guderyon discloses a card comprising a front panel **14** and a rear panel **16** connected at a fold line **24**, the front panel having a front surface, a plurality of peripheral edges, and an interior surface, and a collapsible bag structure **8** attached to the front surface such that the collapsible bag structure is positioned forward of the front panel, the collapsible bag structure having outer edges spaced apart from the peripheral edges of the front panel so that a substantial portion of the front surface of the front panel is viewable, the collapsible bag structure having at least one fold line **20** such that at least a portion of the structure (i.e., the flap **28**) is adjustable to a collapsed condition, wherein the collapsible bag structure is operable to releasably retain an object (the recitation that the object is a gift card is a statement of intended use), and wherein the peripheral edges of the front panel include a top edge and a left edge, the collapsible bag structure has an opening, and the fold line at which the front panel and rear panel are connected is disposed proximal to the left edge of the front panel. See Fig. 2. However, the opening of the collapsible bag structure faces toward the side edge of the front panel. Struhl teaches that it was known in the art to attach a bag structure with its opening facing toward the top edge of the front panel. Compare Figs. 4 and 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to orient the collapsible bag structure toward the top edge of the front panel, as taught by Struhl, in order to store the card in the upright position shown in Fig. 6 of Struhl, as is commonly done.

Regarding claims 1 and 9, a “bag” is defined as “a container of flexible material, such as paper, plastic, or leather, that is used for storing items.”

Regarding claims 2, 3 and 20, a larger bag of the type disclosed by Guderyon could be used as a shopping bag.

Regarding claims 4 and 22, Guderyon discloses a retention element **30**.

Regarding claim 12, an “envelope” is defined as “something that envelops; a wrapping.”

The retaining means disclosed by Guderyon meets that definition.

Regarding claim 18, the claim is a subcombination claim drawn to a card and a container. Limitations drawn to the object to be placed in the container are merely statements of intended use and do not patentably distinguish the claim over the prior art.

Regarding claim 21, the bag structure disclosed by Guderyon is capable of retaining a prepaid gift card. The recitation that the bag “resembles a shopping bag from a retail store” is merely an ornamental consideration, and it has been held that matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re Seid*, 73 USPQ 431.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guderyon (5,288,144) in view of Struhl (5,275,438) as applied to claim 26 above, and further in view of MacWilliams et al. (2002/0050711).

Guderyon discloses the invention substantially as claimed, as set forth above. However, there is no text on the front of the card. MacWilliams teaches that it was known in the art to put text on the front cover of a folder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to put text on the front cover of the folder disclosed by Guderyon, in order to convey information about the contents of the folder.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Struhl (5,275,438) in view of Walton (6,652,178).

Struhl discloses the invention substantially as claimed, as set forth above, including a container attached to a folder sheet. However, the container is not in the form of a collapsible box. Walton teaches that it was known in the art to provide a folder sheet with a collapsible box for storing cards. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the folder sheet disclosed by Struhl with a collapsible box, as taught by Walton, in order to store cards.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guderyon (5,288,144) in view of Struhl (5,275,438) as applied to claim 8 above, and further in view of Walton (6,652,178).

Guderyon discloses the invention substantially as claimed, as set forth above, including a container attached to a folder sheet. However, the container is not in the form of a collapsible box. Walton teaches that it was known in the art to provide a folder sheet with a collapsible box for storing cards. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the folder sheet disclosed by Guderyon with a collapsible box, as taught by Walton, in order to store cards.

***Allowable Subject Matter***

8. Claims 17 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed July 10, 2006 have been fully considered but they are not persuasive.

Regarding Struhl, Applicant asserts that “Struhl fails to disclose each and every limitation described in claim 1.” For example, Applicant contends that “Struhl fails to disclose ‘a greeting card’ as described in claim 1.” Although the preamble of claim 1 is directed to a “greeting card,” the claim limitations that define Applicant’s “greeting card” are fully anticipated by Struhl, as explained above. A greeting card is typically a piece of card stock that is folded in half, which is precisely what Struhl discloses. The Examiner does not believe that merely calling a folded piece of paper a “greeting card” necessarily requires limitations to be read into the claim that are not anticipated by the folder disclosed by Struhl.

Further, Applicant alleges that “Struhl fails to disclose a ‘collapsible bag structure’ that is ‘adjustable to a collapsed condition’ as described in claim 1.” However a “bag” is simply “a usually flexible container” (*Webster’s II New Riverside University Dictionary*, © 1984, p. 146). The flexible computer disc pocket disclosed by Struhl therefore constitutes a bag. Because it is flexible, it is inherently collapsible (e.g., by pressing on the front face thereof). Further, the cover flap is movable from an opened position to a closed (i.e., collapsed) condition.

Further, Applicant alleges that the pocket 18 disclosed by Struhl cannot constitute a “means for retaining and substantially enclosing a gift card.” On the contrary, both the disclosed miniature bag and the pocket disclosed by Struhl perform the same function, that is, they retain small items placed inside them. Both are capable of holding a gift card. MPEP § 2184 states that “Where, however, the specification is silent as to what constitutes equivalents and the examiner has made out a *prima facie* case of equivalence, the burden is placed upon the applicant to show that a prior art element which performs the claimed function is not an equivalent of the structure,



material, or acts disclosed in the specification. See *In re Mulder*, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983)."

Applicant makes the same objections to the Guderyon reference. The above replies apply as well to that reference.

Regarding claim 18, Applicant alleges that the Examiner has improperly ignored some claim elements, and points out that "wherein" clauses cannot be ignored when the element describes "a particular structure." But the limitations in question do not further limit the subject matter of the claim (i.e., the greeting card and bag structure). Rather, they recite features of the article intended to be placed within the bag structure, and they recite those features as objects of a statement of intended use: "the container *being operable to* releasably retain at least a portion of a prepaid gift card in the internal space, wherein when the prepaid gift card is releasably retained by the container, at least one dimension of the prepaid gift card is larger than the internal space such that the prepaid gift card is partially exposed." (Emphasis added). This recitation merely requires that the container be capable of retaining a card that is slightly larger than itself in one dimension, which the containers disclosed by Struhl and Guderyon plainly are. Therefore, contrary to Applicant's assertion, the limitations do not define a size limitation for the internal space of the container, or, if they do, they are met by any container whatsoever, because any container is capable of partially containing an object that is slightly larger than itself in only one dimension.

Regarding the Information Disclosure Statement, the last two items were lined-through because the attachments to which they refer were illegible, and therefore failed to comply with 37 CFR 1.98(a)(2). Copies are attached for Applicant's reference.

*Conclusion*

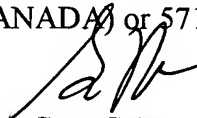
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

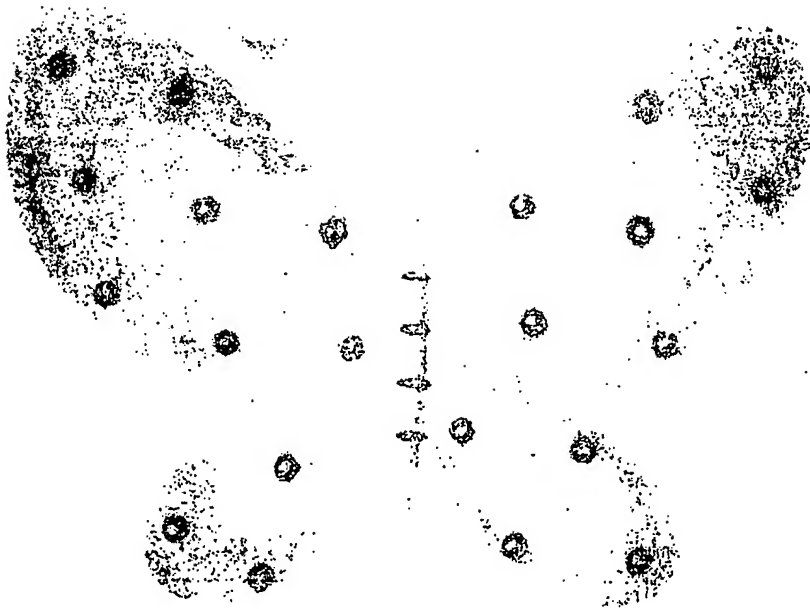


Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch

Best Available

10/759 394



Best Available Copy

Best Available Copy

**Card in  
a Bag!**

Sign and tuck back  
into pocket  
for a nice surprise!

REMOVE BEFORE GIVING

Rub-a-dub-dub, toys in the tub--

(far more than the eye can see!)

Sinkers and floaters, duckies, wee boaters--

what fun a new baby can be!

For:

From: